REMARKS

Summary of the Office Action

Claims 1-8 and 26 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claims 15 and 21 are rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter.

Claims 1-8, 15, 21 and 26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Muratani (U.S. Patent No. 6,804,375) (hereinafter "Muratani").

Summary of the Response to the Office Action

Applicant has amended the claims for clarification purposes, and respectfully traverses the rejections for the reasons set forth below. Claims 1-9, 11-25 and 27-32 remain pending for consideration, with dependent claims 9, 11-14, 16-20, 22-25 and 27-32 being withdrawn.

The 35 U.S.C. § 112, Second Paragraph, Rejection

In this rejection, the Examiner objects to the use of the term "normal" in the claims. Applicant respectfully submits that the use of the term "normal" in the claims does not render the claims indefinite, but rather is simply present to distinguish the "change" copy control information that is used when a changing operation which changes quality of the information signal is performed, from the "normal" copy control information that is used when the changing

operation is not performed. Nevertheless, to advance prosecution, the claims are being amended to remove the term "normal" from the claims. Hence, the claims now recite "change copy control information and "copy control information."

Concerning the rejection of claim 26, Applicant notes that claim 26 is canceled as discussed below.

In view of these amendments, Applicant respectfully requests that the Examiner withdraw this rejection.

The 35 U.S.C. § 101 Rejection

In this rejection, the Examiner contends that claims 15 and 21 are directed to non-statutory subject matter.

With regard to claim 15, Applicant respectfully submits that claim 15 is a method claim that need not be "tied to an apparatus, such as a computer." The method includes "an adding process of adding change copy control information and copy control information to the information signal," and thus alters the information signal. Accordingly, Applicant submits that claim 15 recites a method claim that produces a tangible result (e.g., a physically altered information signal) and thus is statutory under 35 U.S.C. § 101 (See, e.g., M.P.E.P. § 2106 IV(C)(2)).

Concerning claim 21, Applicant respectfully submits that claim 21 recites a program that controls a generating computer to perform certain functions. Hence, Applicant respectfully submits that the program is "tied to an apparatus," produces a tangible result and thus is statutory

under 35 U.S.C. § 101. Nevertheless, to advance prosecution, claim 21 is being amended to explicitly recite that the program is recorded on a computer readable medium and controls the generating computer. Dependent claim 26, which recited the medium on which the program is recorded, is being canceled.

Accordingly, for at least the above reasons, Applicant requests that this rejection be withdrawn.

The 35 U.S.C. § 103(a) Rejection

Claims 1-8, 15, 21 and 26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Muratani. This rejection is respectfully traversed.

As discussed in the Background section of the application, conventional DVDs generally have only one kind of copy control information. However, it may be desirable to distribute a movie with low picture quality and, to promote the movie, allow free copying of that low picture quality version to make the movie more widely available to viewers. Accordingly, the embodiments of the present invention enables two types of copy control information, namely, change copy control information and (normal) copy control information, to be added to the information signal. The change copy control information is used when the quality of the information signal is changed, for example, degraded, so that a certain level of copying of the degraded quality information signal may be permitted. The (normal) copy control information is used when the quality of the information signal is not changed so, for example, copying of the unchanged (e.g., high quality) signal can prohibited or limited.

Independent claim 1 explicitly recites "an information generating apparatus comprising and adding device which adds change copy control information and copy control information to an information signal." As further recited in claim 1, the change copy control information is used "when a changing operation which changes quality of the information signal is performed," and the (normal) copy control information is used "when the changing operation is not performed." Rejected independent claims 15 and 21 recite a method and computer program, respectively, for adding the two types of copy control information to the information signal. Accordingly, as discussed above, because the information signal has two different types of copy control information added to it, different modes of copy protect can be performed depending on whether the information signal is changed or not.

Muratani teaches an apparatus and method for detecting electronic watermarks. The Examiner cites column 1, lines 32-40, in particular, as teaching a method for embedding an electronic watermark within digital content. The Examiner admits that Muratani does not disclose change copy control information and normal copy control information as claimed in the present application. Nevertheless, the Examiner concludes that it would have been obvious to add "any kind of information to the watermark."

Applicant respectfully submits, however, that Muratani merely teaches a single type of watermark information that can have different parameters. However, in the claimed embodiments of the present application, two different types of copy control information are added to the information signal and are thus present in the information signal at the same time so that different types of copy protection can be achieved depending on whether or not the quality of the signal has been changed.

In the rejection, the Examiner states that the "functional" word "for" is given little patentable weight, and cites *In re Casey, 370 F.2d 576, 152 USPQ 235 (CCPA 1967).* Applicant respectfully submits that to advance prosecution, the "for" language has been eliminated from the claims. Furthermore, Applicant respectfully notes that as explained in M.P.E.P. § 2114, structural differences between the claim and the prior art can be used to distinguish over that prior art. *See, e.g., In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997).*

Independent claim 1 explicitly recites the structure of "an adding device which adds change copy control information and copy control information to an information signal." Applicant respectfully submits that Muratani fails to teach any such "adding device" that adds these two different types of copy control information to an information signal. Accordingly, Applicant respectfully submits that claim 1 recites structure that is not found in Muratani. Again, Muratani merely describes embedding a watermark in digital content, not multiple different types of copy control information that each provides different types of copy protection. Independent claim 15 recites a process of adding these two different types of copy control information to an information signal, and Muratani fails to teach any structure capable of performing this process. Likewise, independent claim 21 recites a program for controlling a computer to act as an adding device (i.e., structure) which adds the two different types of copy control information to the information signal, and which Muratani is lacking.

Accordingly, for at least the above reasons, Applicants respectfully submit that one skilled in the art would not have found it obvious to have achieved the embodiments of the present invention even as recited in independent claims 1, 15 and 21 simply from the teachings

of Muratani. Accordingly, claims 1, 15 and 21, and dependent claims 2-8, should be allowable.

In addition, Applicant realizes that independent claims 9, 12, 13, 14, 16, 17, 18, 19, 20, 22-25 and 29 were withdrawn from consideration. However, Applicant respectfully notes that each of these claims either explicitly recites adding the two types of copy control information (i.e., change copy control information and copy control information) to a signal, or an information signal to which has been added change copy control information and copy control information. For example, independent claim 9 recites "[a]n information reproducing apparatus for reproducing an information signal, to which change copy control information and copy control information are added, the change copy control information being used when a changing operation which changes quality of the information signal is performed, the copy control information being used when the changing operation is not performed."

Applicant realizes that in claim 9 and in certain other independent claims, the change copy control information and copy control information are recited in the preamble. Nevertheless, Applicant notes that as explained in M.P.E.P. § 2111.02, "[i]f the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). *See also, Jansen v. Rexall Sundown, Inc.*, 342 F.3d 1329, 1333, 68 USPQ2d 1154, 1158 (Fed. Cir. 2003). Also, any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation. *See, e.g., Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989) (The determination of whether preamble

recitations are structural limitations can be resolved only on review of the entirety of the application "to gain an understanding of what the inventors actually invented and intended to encompass by the claim."); *Pac-Tec Inc. v. Amerace Corp.*, 903 F.2d 796, 801, 14 USPQ2d 1871, 1876 (Fed. Cir. 1990) (determining that preamble language that constitutes a structural limitation is actually part of the claimed invention).

Applicant respectfully submits that the terms "change copy control information" and "copy control information," which are used in the preambles of certain claims, are also referred to in the body of those claims. Thus, Applicant submits that each of the preambles of those claims "recites limitations" of those claims and is "necessary to give life, meaning, and vitality" to those claims. Accordingly, the limitations in the preamble of those claims should be viewed as part of those claims when determining patentability. That being said, if the Examiner finds claims 1, 15 and 21 to be allowable, Applicant respectfully requests that the Examiner rejoin the withdrawn claims back into the application and find them allowable as well, since they recite the allowable "change copy control information" and "copy control information" features which led to the allowance of claims 1, 15 and 21.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully submit that all of the pending claims are now in prima-facie condition for allowance, and respectively request the timely allowance of the pending claims. Withdrawal of all outstanding rejections and objections is respectfully requested. Should the Examiner feel that there are any issues outstanding after

consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution. A favorable action is awaited.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. § 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0573. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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Dated: February 20, 2009

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